

CST

January 15, 2009

In re application of
Paul Meredith
Serial No. 10/579,654
Filed: May 18, 2006
For: SILICA FILMS AND METHOD
OF PRODUCTION THEREOF : DECISION ON REQUEST TO
PARTICIPATE IN PATENT
PROSECUTION HIGHWAY
PILOT PROGRAM AND
PETITION TO MAKE SPECIAL
UNDER 37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program filed November 14, 2008.

The request and petition are **DISMISSED** as moot. Specifically, a requirement for restriction was mailed in this application on November 14, 2008, and applicant timely filed a response to this restriction requirement on December 15, 2008.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the IPAU, note where the IAU application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the IAU application with similar claims and the IAU priority application;

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the IAU application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO to obtain a copy from DAS; however, if the USPTO is unable to obtain a copy from the DAS, the applicant will be required to submit a copy;
- b. An English translation of the allowable/ patentable claim(s), if applicable; and
- c. A statement that the English translation is accurate, if applicable;

(3) Applicant must:

- a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the IAU application(s); and
- b. Submit a claims correspondence table in English;

- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit:
- a. Documentation of prior office action:
 - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the IPAU application(s) containing the allowable/patentable claims(s) or
 - ii. if the allowable/patentable claim(s) are from "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
 - iii. if the IPAU application is a first action allowance then no office action from the IPAU is necessary should be indicated on the request/petition form:
Further, if a copy of the documents from a or b is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of the DAS, the applicant will be required to submit a copy;
 - b. An English language translation of the IPAU Office action from (5)(a)(i)-(ii) above if applicable; and
 - c. A statement that the English translation is accurate;
- (6) Applicant must submit:
- a. An IDS listing the documents cited by the IPAU examiner in the IPAU office action (unless already submitted in this application)
 - b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application); and
- (7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition fail because:

(4) Examination of the U.S. application has begun. Specifically, note that a requirement for restriction was mailed on November 14, 2008, and that a response to this restriction requirement was timely filed on December 15, 2008.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Christine Tierney/

Christine Tierney
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